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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,184	09/03/2003	Sven-Erik Carlson	H60-113 US	5172
21706	7590	07/12/2006	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			WINAKUR, ERIC FRANK	
			ART UNIT	PAPER NUMBER
			3768	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/654,184	Applicant(s) CARLSON ET AL.	
	Examiner Eric F. Winakur	Art Unit 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5,6,8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8 and 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Objections***

2. Claims 1, 5, 12, 15, and 16 are objected to because of the following informalities: With regard to claim 1, it appears that the term "comprising" (line 6) should read "comprises" and the term "wherein" should be inserted before "the light source" (line 14). With regard to claim 5, it appears that the term "comprising" (line 6) should read "comprises". With regard to claim 12, it appears that the term "neglectable" (line 4) should read "negligible". With regard to claim 15, it appears that the term "comprising" (line 6) should read "comprises"; the term "wherein" should be inserted before "the light" (line 11); and the term "and" should be inserted before "the LED" (line 16). With regard to claim 16, it appears that the term "claim" (line 3) should read "clamping". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. Claims 1, 8, 13, 15, 16, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claims 1, 15, and 18, it is unclear how an apparatus can have a light receiver for determining light reflected through a tissue portion and have the photo detecting element adjacent an opposite side of the tissue from the emitter; it appears that the phrase "and/or reflected" should be deleted from the claims to limit the claims to a transmission arrangement

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which is consistent with the claimed structure. With regard to claim 13, the phrase "preferably above 500 Hz" sets forth an additional range in the claim and renders the scope of the claimed subject matter unclear.

***Claim Rejections - 35 USC § 103***

4. The rejection of claims 5, 6, 10 - 14 and 17 under 35 U.S.C. 103(a) as being unpatentable over Caro in view of Tsuchiya is hereby maintained. Caro teaches providing a pulsoximetric sensor having one or more LEDs (column 9, lines 43 - 46), a light receiver (112), and beam shaping elements (137, 202, 116, 118) for directing the light from the LEDs, through the beam shaping elements, and into substantially the same location on the tissue. The light receiver (112) includes a silicon photodiode [column 16, line 1] (disclosed by Applicant in the specification, as filed, p. 12 and Figure 5b, as being sensitive or tuned to the wavelengths emitted by the light source). Further, Caro teaches that substantially all of the components may be incorporated into the finger clip (column 7, lines 59 - 62) but does not teach that the LEDs are essentially arranged to directly emit to the tissue portion. Tsuchiya teaches alternate equivalent arrangements for illuminating tissue (Figures 13, 14, 15 and the descriptions thereof). It would have been obvious to modify the illumination arrangement of Caro to use essentially direct illumination from the LEDs to the tissue, as taught by Tsuchiya, since it has generally been held to be within the skill level to substitute alternate equivalent expedients.

***Response to Arguments***

5. Applicant's arguments filed 25 April 2006 have been fully considered but they are not persuasive. Applicant contends that claim 5 has been amended to incorporate limitations not found in the combination of Caro and Tsuchiya. However, as detailed in paragraph 4 above, Caro teaches an arrangement that includes a silicon photodiode, which is a "photo detecting element sensitive or tuned only to the wavelengths emitted by the light source" per the teaching of Applicant's specification, page 12 and Figure 5b. As such, Applicant's amendment has not defined over the combination.

***Allowable Subject Matter***

6. Claims 1, 8, 15, 16, and 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and objections set forth in this Office action.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

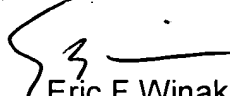
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571/272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Eric F Winakur  
Primary Examiner  
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